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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,151	04/24/2001	Yoshiko Akazawa	1573.1005	3422

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EXAMINER

PESIN, BORIS M

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 11/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,151

Applicant(s)

AKAZAWA ET AL.

Examiner

Boris Pesin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 37 recites the limitation "said second virtual world" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 38 recites the limitation "said second virtual world" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claim ^{§ 35-38}~~35~~ is rejected under 35 U.S.C. 102(b) as being anticipated by Burge (US 6014638).

In regards to claim 35, Burge discloses a method of storing information inputted by the user in a memory device (Column 5, Line 60). Burge further discloses a method for analyzing said inputted data stored in the memory device to derive a feature of the user (Column 5, Line 64). Burge further discloses a method for determining a virtual

world in accordance with the user's feature (Column 6, Line 1). Burge further discloses a method for presenting data associated with the virtual world to a device of the user (Column 10, Line 14).

In regards to claim 36, Burge discloses that the user inputted data is message data (Column 5, Line 61).

In regards to claim 37, though Burge does not specifically disclose that he obtains the data associated with the virtual world though an URL, it is inherent in the invention that when something is accessed on the Internet, it is via a URL.

In regards to claim 38, Burge discloses a method where in the data associated with said virtual world is The Merchants Products and Services Database, or the definition data (Column 9, Line 61).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claim 1 - 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burge et al. (US 6014638) in view of Brush et al. (US 5884029).

In regards to claim 1, Burge discloses an information processing apparatus for storing the data inputted by the user and storing data representative of a plurality of virtual worlds (Column 5, Line 51 and Column 9, Line 61). Though Burge does not specifically indicate that the information is stored in memory, it is inherent in the invention that the information is stored in memory. Burge further discloses a processor causing an image of a first virtual world to be displayed on a display (Abstract, Line 5). Though Burge does not specifically disclose that the first virtual world is being stored in the memory, it is inherent in the invention. Burge further discloses a predefined object that is associated with a specific content in his virtual world (Column 5, Line 64). Burge further discloses the ability to analyze the actions of the avatar, or user, in the virtual world and to derive a feature of the user and from that derive a second virtual world which includes another object, and the other object having a specific position and content (Column 6, Line 50). It is inherent in Burge's invention that the processor allows the image to be displayed on the display.

Burge lacks the ability to have an avatar in his virtual world. Brush teaches that, "Using the example of the virtual shopping mall, lets assume that an avatar enters the virtual department store. Upon entering the department store his presence is detected by the virtual salesperson." (Column 7, Line 6). Brush teaches that an avatar has the

ability to walk throughout the store and examine the contents of it, and as the avatar is doing so, his coordinates are recorded. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Burge's invention and modify it to include Brush's teachings, specifically add an avatar in his virtual mall in order to give the user a better shopping experience and make the user feel like he is actually at the mall.

In regards to claim 2, Burge and Brush disclose all the limitations of claim 1, and further disclose wherein a set of definition data of said virtual world is selected from sets of definition data of respective virtual worlds (Burge Column1, Line 61).

In regards to claim 3, Burge and Brush disclose all the limitations of claim 1, and further disclose the ability to derive the feature of the user from the position of the avatar, or user, relative to the predefined object (Burge Column 6, Line 56).

In regards to claim 4, Burge and Brush disclose all the limitations of claim 1. Brush teaches that upon "chatting" with an avatar about what he is interested in purchasing, the computer is able to make some suggestions to the user (Brush Column 8, Line 35). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Brush's teachings and modify Burge's invention in such a way so as to incorporate messaging in the system in order to aid in the creation of a profile of the user so as to assist him in choosing things he is interested in.

In regards to claim 5, Burge and Brush disclose all the limitations of claim 1, and further disclose the ability to derive the feature of the user from the data related to the user (Burge Column 5, Line 60).

In regards to claim 6, Burge and Brush disclose all the limitations of claim 1, and further disclose the ability to have an avatar in the second virtual world.

In regards to claim 7, Burge and Brush disclose all the limitations of claim 1, but do not specifically disclose the ability to give weights to the user's features. However Burge does disclose a process of determining display characteristics and elements based on a predictive model (Column 9, Line 26). Since he has a predictive model, it is inherent that some kind of weighting system has to be present.

In regards to claim 8, Burge and Brush disclose all the limitations of claim 1, but do not specifically disclose the ability to access the definition data of the virtual world with the URL. However it is inherent in the invention that when something is accessed on the Internet, it is via a URL.

4. Claim 9 is in the same context as claim 1, it is therefore rejected under similar rationale.

Claim 10 is in the same context as claim 2, it is therefore rejected under similar rationale.

Claim 11 is in the same context as claim 3, it is therefore rejected under similar rationale.

Claim 12 is in the same context as claim 4, it is therefore rejected under similar rationale.

Claim 13 is in the same context as claim 5, it is therefore rejected under similar rationale.

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Claim 14 is in the same context as claim 6, it is therefore rejected under similar rationale.

Claim 15 is in the same context as claim 7, it is therefore rejected under similar rationale.

Claim 16 is in the same context as claim 8, it is therefore rejected under similar rationale.

In regards to claim 17, Burge and Brush disclose all the limitations of claim 9, and further disclose a Merchants Products and Services Database (Burge, Column 9, Line 61), or definition data, that may be used to create a virtual world based on the users interests.

5. Claims 18-25 are in the same context as claims 1-8 respectively, they are therefore rejected under similar rationale.

6. Claims 26-34 are in the same context as claims 9-17 respectively, they are therefore rejected under similar rationale.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US006572662B2

Manohar et. al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is 703-305-8774. The examiner can normally be reached on Monday-Friday with the exception of every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Kristine Kincaid
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